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**OFFICE OF PETITIONS**

In re Application of :  
Stephan Doliov :  
Application No. 09/765,802 : DECISION ON APPLICATION  
Filed: January 19, 2001 : FOR  
Attorney Docket No. 9623/314 : PATENT TERM ADJUSTMENT  
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This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)," filed May 16, 2005. Applicant requests that an additional 169 days be added to the patent term adjustment based on the Office taking in excess of three years to issue the patent<sup>1</sup>.

The application for patent term adjustment is **DISMISSED**.

On February 23, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 900 days. Applicant requests additional patent term for Office delay in issuing the patent.

Ordinarily, a decision on application for patent term adjustment based on the Office taking in excess of three years to issue the patent is held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). However, in this instance, such

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<sup>1</sup> Otherwise, applicant agrees with the initial determination of patent term adjustment at the time of the mailing of the notice of allowance.

abeyance is not necessary because the end date for calculating the period of adjustment pursuant to §§ 1.702(b) and 1.703(b) is known.

The period of adjustment under 1.702(b) does not include:

The number of days, if any, in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Thus, the filing of the request for continued examination (RCE) (in an application filed on or after May 29, 2000) cuts off any additional PTA due to failure to issue a patent within three years of the actual filing date, but does not otherwise affect PTE or PTA. On June 9, 2005, applicant filed a RCE in the instant application. Accordingly, June 9, 2005 (not the patent issue date) is the end date for calculating the period of adjustment accrued for Office delay in issuing the patent within three years.

As of the filing of the RCE on June 9, 2005, the application had been pending 3 years and 507 days after its filing date. However, if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004). In this instance, the period of delay of 903 days attributable to grounds specified in § 1.702(a)(1) overlaps with the 507 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 903 days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to Technology Center AU 2165 for consideration of the Request for Continued Examination (RCE) filed June 9, 2005.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter  
for

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